

0.001-95% of a lipophilic particulate selected from the group consisting of inorganic pigment, organic pigment, particulate fillers, and mixtures thereof.

32. **(Withdrawn)** The lipstick composition of claim 31 wherein the film forming polymer comprises a silicone.

33. **(Withdrawn)** The lipstick composition of claim 31 wherein the film forming polymer comprises a copolymer of silicone and ethylenically unsaturated monomers.

34. **(Withdrawn)** The lipstick composition of claim 31 wherein the film forming polymer comprises a polymer made by polymerizing ethylenically unsaturated monomers.

35. **(Withdrawn)** The composition of claim 31 wherein the polymer is made by polymerizing one or more silicones, one or more ethylenically unsaturated monomers, and one or more organic groups.

36. **(Withdrawn)** The composition of claim 31 wherein the volatile silicone comprises octamethyltrisiloxane.

37. **(Withdrawn)** The composition of claim 31 wherein the volatile silicone comprises decamethyltetrasiloxane.

38. **(Withdrawn)** The composition of claim 31 wherein the volatile silicone comprises dodecamethylpentasiloxane.

39. **(Withdrawn)** The composition of claim 31 wherein the volatile silicone comprises tetradecamethylhexasiloxane.

40. **(Withdrawn)** The composition of claim 31 wherein the volatile paraffinic hydrocarbon is selected from the group consisting of isododecane, isohexadecane, and mixtures thereof.

### REMARKS

Claims 1-40 are pending in the application. Claims 3, 5, 6, 8-11, 13-18, 21, 22, 24, 25, and 28-40 are withdrawn from consideration by the Examiner as part of an earlier Restriction Requirement. Claims 1, 2, 4, 7, 12, 19, 20, 23, 26, and 27 are rejected in this Office Action. Claim 1 is rejected under 35 U.S.C. §112 second paragraph. Claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27 are rejected under 35 U.S.C. §102 (a) and (e). Claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27 are rejected under 35 U.S.C. §103(a). Claims 1, 7, 12, 19, 23, and 26 are rejected on the ground of nonstatutory obviousness-type double patenting.

#### Rejection Under 35 U.S.C. §112, First Paragraph

Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner finds unclear what "[a] long wearing cosmetic composition" would encompass.

In response claim 1 has been amended to remove the language "long wearing".

Based on the above amendment applicants have removed the grounds for rejection and request that the Examiner allow claim 1.

#### Rejections Under 35 U.S.C. §102 (a) and (e)

Claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27 are rejected under 35 U.S.C. §102 (a) and (e) as being anticipated by Ferrari, *et al* (US 2002/0164297) ("Ferrari").

The Examiner alleges that Ferrari discloses a cosmetic composition containing polymers, volatile oils, and fillers. The Examiner additionally alleges Ferrari inherently teaches the use of more than one polymer.

Applicant respectfully traverses the Examiner's rejection.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

Applicants claim, "[a] ~~long-wearing~~ cosmetic composition comprising at least one film forming polymer solvated in volatile linear siloxane, at least one lipophilic particulate, and at least one multifunctional ingredient that interacts with one or more of the other ingredients present with the ingredients present forming a homogeneous composition."

The composition in Ferrari requires a colloidal dispersion of solid particles (paragraphs 0012, 0018, 0027, 0028 ) and polymer particles (paragraphs 0013, 0023, 0024, 0029, 0033). Ferrari does not disclose a homogeneous composition.

Ferrari does not disclose all the elements of applicants independent claim 1 and dependant claims 2, 4, 7, 12, 19-20, 23, 26, and 27 and therefore Ferrari does not anticipate applicant's invention.

Based on the above-identified facts applicants request the Examiner to withdraw the 35 U.S.C. §102 (a) and (e) rejection and allow claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27.

#### Rejections Under 35 U.S.C. §103

The Examiner rejects claims 1, 2, 4, 7, 12, 19-20, 23, 26, and 27 under 35 U.S.C. §103(a) as being obvious over U.S. Patent Publication No. 2002/0164297 (Ferrari), published November 7, 2002.

The Examiner claims that Ferrari discloses the optional use of volatile solvents in the cosmetic composition.

The Examiner further claims that use of a volatile oil such as octamethyltrisiloxane would make applicant's invention obvious.

A proper obviousness analysis requires that the Examiner must establish a *prima facie* case of unpatentability based on obviousness. In doing so the Examiner should evaluate the totality of the facts and all the evidence to determine whether the claimed invention would have been obvious. MPEP § 2144.08 (II).

In determining obviousness, §103 expressly requires considering the claimed invention "as a whole." Focusing the §103 inquiry on a particular aspect of the invention that differs from the prior art improperly disregards the "as a whole" statutory mandate. *See Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1383, 231 U.S.P.Q. at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, as the district court did in frequently describing the claimed invention as the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay, was a legally improper way to simplify the difficult determination of obviousness."); *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 U.S.P.Q. 1021, 1026 (Fed. Cir. 1984) (treating an unclaimed advantage as the gist of the patented invention "disregards the statutory requirement that the invention be viewed 'as a whole,' ignores the problem-recognition element, and injects an improper 'obvious to try' consideration"); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004)(The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. ... This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention."); *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed.Cir. 2005):

The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. ... Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. ... This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve

a new result--often the essence of invention. [internal citations to *Ruiz* omitted].

Applicants claim, "[a] ~~long-wearing~~ cosmetic composition comprising at least one film forming polymer solvated in volatile linear siloxane...forming a homogeneous composition."

In this Office Action The Examiner has focused on the obviousness of substitutions instead of on the invention as a whole. It is well established in the cases presented above that this is an improper way to simplify the difficult determination of obviousness.

Ferrari requires, "the polymer is a solid that is insoluble in the fatty phase", (paragraph 0019).

In paragraph [0016] of Ferrari defines "volatile fatty phase" as especially comprises oils... The Examiner recites paragraph [0016] when describing solvents that have evaporated off from the skin and lips.

As previously pointed out the invention of Ferrari requires dispersions of particles and polymers. Therefore any volatile solvent optionally used in Ferrari would have to be one that would not allow the polymer to be solvated in the solvent so as to form a homogeneous composition.

As discussed above, the Examiner's focus on substitutions of ingredients instead of on the invention as a whole does not make a *prima facie* case of unpatentability based on obviousness. It is Applicants' position that the pending amended claims are patentable over the reference. The Examiner is respectfully requested to reconsider the rejection under 35 U.S.C. §103(a).

#### Rejections Under Double Patenting

Claims 1, 7, 12, 19, 23, and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-14 and 18-20 of copending Application 10/364,245.

The Examiner must provide some clear evidence to establish why the invention's variation in the second patent or application would have been obvious. See *In re Kaplan*, 789 F.2d at 1580, 229 U.S.P.Q. at 683.

In this case, the Examiner has recited a partial list of ingredients found in cosmetics without regard to the complete description of the required combinations of the various ingredients recited and not recited that make these applications separately patentable,

The claims of the Application 10/364,245 require the cosmetic composition to contain polymethylsilsesquioxane, dimethicone and at least one volatile hydrocarbon selected from the group isododecane, isohexadecane, and mixtures thereof.

The subject application does not contain the required hydrocarbons or linear polymer of the 10/364,245 application.

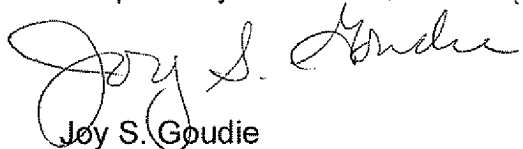
The rejected claims need to be shown to be unobvious in view of the claim(s) upon which they were rejected. See *In re Gladrow*, 406 F.2d 1376 (C.C.P.A. 1969) (holding that unexpected results required reversal of double patenting rejections of some claims); *Pfizer v. Ranbaxy Labs.*, --- F.Supp.2d ----, 2005 WL 3454227 (D.Del. Dec. 16, 2005).

Applicants submit that the subject application and the 10/364,245 application claim different inventions and therefore request removal of the double patenting rejection.

In view of the above amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance and earnestly request such action.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Joy S. Goudie".

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